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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,171	03/17/2004	Ellen Lasch	37355-237	3870

7590 11/03/2004
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EXAMINER

WALSH, DANIEL I

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/802,171

Applicant(s)

LASCH ET AL.

Examiner

Daniel I Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-10, 13-15, and 17-20 is/are rejected.
- 7) ☒ Claim(s) 8, 11, 12 and 16 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8-04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of the term “transaction card” renders the claims vague/indefinite. It is unclear to the Examiner what a transaction card is. As interpreted by the Examiner, and in accordance with prior art teachings, transaction cards can include credit/debit cards, etc. and also SIM cards.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4, 5, 9, and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Combaluzier (US 5,973,475).

Re claim 1, Combaluzier teaches a portable electronic device and a transaction card interconnected with the portable electronic device (FIG. 1).

Re claim 2, Combaluzier teaches the device is a mobile telephone (abstract)

Re claim 4, Combaluzier teaches the transaction card is removable (slot 3).

Re claim 5, Combaluzier teaches the card is disposed in a housing (2) that is interconnected with the electronic device (phone).

Re claim 9, Combaluzier teaches the transaction card is removably disposed in the housing (slot 3).

Re claims 18-19, Combaluzier teaches the housing is removable from the transaction device (as it is a battery that is replaceable), and the transaction card is removable from the housing (slot 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 3, 6, 7, 10, 17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Combaluzier, as applied above, further in view of Ueda (US 5,004,899).

Re claims 3, 6, 7, 10, 17, and 20 the teachings of Combaluzier have been discussed above.

Combaluzier is silent to the card being foldable.

Re claims 3 and 6, Ueda (5,004,899) teaches a foldable IC card (abstract). Re claim 7, Ueda teaches the foldable card has a first and second section with a hinge disposed between them (FIG. 1a+). Re claims 10 and 17, the Examiner has interpreted the portion of the card (1) containing IC (7), as the second portion, which contains an electronic storage means for storing information removable from the reader, and that the first section of the card does not contain the IC chip. However, the Examiner notes that the total card is interpreted to be attached to the housing, when it is inserted as it is interpreted by the Examiner to be pressed against the walls of the housing, as is well known and conventional in the art, as an obvious expedient to help secure the card in the housing for reading, for example. Re claim 20, when folded, it is obvious that the card has dimensions smaller than a traditional transaction card, as the transaction card is folded.

At the time the invention was made, it would have been obvious to combine the teachings of Combaluzier with those of Ueda.

One would have been motivated to do this to have a card that is convenient to carry and affords protection from static destruction.

4. Claim 13, 14, and 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Combaluzier.

The teachings of Combaluzier have been discussed above.

Re claims 13-14, Combaluzier teaches a slot to insert the card, but is silent to a track attached to the housing. The Examiner notes that tracks/guides are well known and conventionally used in a card reader to facilitate correct orientation/insertion of the card. Therefore, it would have been obvious to an artisan of ordinary skill in the art to modify the teachings of Combaluzier as a means to provide guide means to facilitate correct card insertion. Such modifications are well known and conventional in the art, and produces expected results (see US 5,912,446 FIG. 2 as an example of attaching means/track/guide means of a card reader to guide the card insertion). Re claim 15, Combaluzier teaches an opening slot, but is silent to an opening means for opening the housing to access the card therein. The Examiner notes that flaps/gates/doors/panels to cover an opening of an electrical device, such as a conventional floppy disk drive, automobile tape player, card reader, are well known and conventional means of protecting the internals of the electrical device, while also permitting the ejection of the card/tape/etc., as such flaps are readably opened with little applied pressure required. The Examiner notes that simply using a cover to cover the opening of the card reader of Combaluzier is obvious to one of ordinary skill in the art, to protect the internals of the electronic device (see US 2001/0010608 for an example; additionally, Mansutti et al. US 2001/0003071 teaches a phone with a card reader and opening means 25 to access the cards therein.). The examiner notes that simply providing a covering to an opening is more than obvious to one of ordinary skill in the art to protect internal components.

5. Claims 1, 5, and 15 are additionally rejected under 35 U.S.C. 103(a) as being unpatentable over Wallace et al. (US 5,933,328).

Wallace et al. teaches an opening means of a housing to access a transaction card disposed therein, where the transaction card is interconnected with the portable electronic device, and the housing is interconnected with the portable electronic device (FIG. 2). Though the card 23 is not explicitly described as a transaction card, it is well known and conventional that SIM cards can be used to facilitate transactions, and therefore is broadly interpreted as a transaction card.

Allowable Subject Matter

6. Claims 8, 11, 12, and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach the card is folded when its in the housing and that the second section unfolds outside the housing when the housing is opened.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Savalle et al. (US 5,915,016), Wong et al. (US 5,912,446), Liu, Shih-Yuan (US 2003/0153356), Ueda (US 4,849,617), Lasch et al. (US 2004/0169087 2004/0144846 2004/0089724), Knighton et al. (US 6,032,866), Kokubu (US 5,710,421), Solo (US 4,562,342), Mansutti et al. (US 2001/0003071), Keller (US 5,700,037), Bailey (US 2004/0104268), and Lefbvre et al. (US 6,171,138).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached between the hours of 7:30am to 4:00pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone numbers for this Group is (703) 308-7722, (703) 308-7724, or (703) 308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[daniel.walsh@uspto.gov]**.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set for the in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

DW
10/22/04



KARL D. FRECH
PRIMARY EXAMINEE

